

PATENT
Docket No.: **D/A1496 (1508/3550)**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Sarah E. Campbell, Ken Hayward, and Marc J. Krolczyk)	Examiner: Yixing Qin
Serial No.	:	10/055,189)	Art Unit: 2625
Cnfrm. No.	:	9199)	
Filed	:	January 25, 2002)	
For	:	A METHOD AND SYSTEM FOR SHOPPING FOR A CONSUMABLE FOR A DEVICE)	

**AMENDMENT AND RESPONSE TO NOTICE OF NON-COMPLIANT
AMENDMENT (37 CFR 1.121), DATED AUGUST 2, 2006**

MAIL STOP AMENDMENT
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In further response to the Office Action dated April 20, 2006, and in response to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed on August 2, 2006, please replace the Amendment filed on June 30, 2006, with the present submission.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. (Currently Amended) A method comprising:
requesting, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device;
receiving, at the peripheral device via the communications network, information identifying at least one supplier for the at least one consumable based on the request; and
indicating, with the peripheral device, the identified at least one supplier.

2. (Previously Presented) The method as set forth in claim 1, further comprising indicating, at the peripheral device, when replacement of at least one of the consumables in the peripheral device is recommended, wherein the request is based on the indication of the recommended replacement.

3. (Previously Presented) The method as set forth in claim 31, further comprising retrieving information about the peripheral device making the request, wherein the identifying the at least one supplier is based on the retrieved information.

4. (Previously Presented) The method as set forth in claim 3, wherein the retrieved information about the peripheral device identifies a location of the peripheral device, and the identifying the at least one supplier is based on the identified location of the peripheral device.

5. (Previously Presented) The method as set forth in claim 1, wherein the received information further comprises information identifying a quantity of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating the identified quantity of the at least one consumable.

6. (Previously Presented) The method as set forth in claim 1, wherein the received information further comprises information identifying a price of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating each identified price of the at least one consumable.

7. (Previously Presented) The method as set forth in claim 1, wherein the received information further comprises information identifying a location of the identified at least one supplier, and the indicating further comprises indicating the location of the identified at least one supplier.

8. (Previously Presented) The method as set forth in claim 1, further comprising submitting, with the peripheral device, an order for the at least one consumable to the at least one identified supplier.

9. (Previously Presented) The method as set forth in claim 8, further comprising:

processing the submitted order; and
supplying the at least one consumable for the peripheral device.

10. (Previously Presented) The method as set forth in claim 9, wherein the processing the submitted order further comprises receiving a payment for the at least one consumable.

11. (Currently Amended) A computer readable medium having stored thereon instructions for shopping for at least one consumable for a peripheral device which, when executed by at least one processor, cause the processor to perform the steps of:

requesting, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device;

receiving, at the peripheral device via the communications network, information identifying at least one supplier for the at least one consumable based on the request; and

indicating, with the peripheral device, the identified at least one supplier.

12. (Previously Presented) The medium as set forth in claim 11, further comprising indicating, at the peripheral device, when replacement of at least one of the consumables in the peripheral device is recommended, wherein the requesting is based on the indication of the recommended replacement.

13. (Previously Presented) The medium as set forth in claim 32, further comprising retrieving information about the peripheral device making the request, wherein the identifying the at least one supplier is based on the retrieved information.

14. (Previously Presented) The medium as set forth in claim 13, wherein the retrieved information about the peripheral device identifies a location of the peripheral device, and the identifying the at least one supplier is based on the identified location of the peripheral device.

15. (Previously Presented) The medium as set forth in claim 11, wherein the received information further comprises information identifying a quantity of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating the identified quantity of the at least one consumable.

16. (Previously Presented) The medium as set forth in claim 11, wherein the received information further comprises information identifying a price of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating the identified price of the at least one consumable.

17. (Previously Presented) The medium as set forth in claim 11, wherein the received information further comprises information identifying a location of the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating the location of the identified at least one supplier.

18. (Previously Presented) The medium as set forth in claim 11, further comprising submitting, with the peripheral device, an order for the at least one consumable to the at least one identified supplier.

19. (Previously Presented) The medium as set forth in claim 18, further comprising:

processing the submitted order; and
supplying the at least one consumable for the peripheral device.

20. (Previously Presented) The medium as set forth in claim 19, wherein the processing the submitted order further comprises receiving a payment for the at least one consumable.

21. (Currently Amended) A system comprising:

a requesting system that requests, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for the at least one consumable for the peripheral device;

a receiving system of the peripheral device that receives, via the communications network, information identifying at least one supplier for the at least one consumable based on the request; and

an indication system, with the peripheral device, that indicates the identified at least one supplier.

22. (Previously Presented) The system as set forth in claim 21, further comprising an indication system that indicates at the peripheral device when replacement of one or more of the consumables in the peripheral device is recommended, wherein the request by the requesting system is based on the indication of the recommended replacement.

23. (Previously Presented) The system as set forth in claim 33, further comprising a retrieval system that retrieves information about the peripheral device making the request, wherein the identification system identifies the at least one supplier based on the retrieved information.

24. (Previously Presented) The system as set forth in claim 23, wherein the retrieved information about the peripheral device identifies a location of the peripheral device, and the identification system identifies the at least one supplier based on the identified location of the peripheral device.

25. (Currently Amended) The system as set forth in claim 21, wherein the received information identifies a quantity of the at least one consumable at the identified at least one supplier, wherein the indication system indicates the identified quantity of the at least one consumable.

26. (Previously Presented) The system as set forth in claim 21, wherein the received information further comprises information identifying a price of the at least one consumable at the identified at least one supplier, and the indication system indicates the identified price of the at least one consumable.

27. (Previously Presented) The system as set forth in claim 21, wherein the received information further comprises information identifying a location of the identified at least one supplier, and the indication system indicates the location of the identified at least one supplier.

28. (Previously Presented) The system as set forth in claim 21 further comprising an ordering system with the peripheral device for submitting an order for the at least one consumable to the at least one identified supplier.

29. (Previously Presented) The system as set forth in claim 28 further comprising an order processing system for processing the submitted order for the at least one consumable for the peripheral device.

30. (Previously Presented) The system as set forth in claim 29, wherein the processing system processes a payment for the at least one consumable.

31. (Previously Presented) The method as set forth in claim 1, comprising: receiving the request, and

identifying the at least one supplier for the at least one consumable based on the received request.

32. (Previously Presented) The medium as set forth in claim 11, comprising:

receiving the request, and

identifying the at least one supplier for the at least one consumable based on the received request.

33. (Previously Presented) The system as set forth in claim 21, comprising an identification system for receiving the request and identifying the at least one supplier for the at least one consumable based on the request.

34. (Previously Presented) The method as set forth in claim 1, wherein said indicating the identified at least one supplier comprises at least one of displaying received identification information and printing received identification information.

35. (Previously Presented) The medium as set forth in claim 11, wherein said indicating the identified at least one supplier comprises at least one of displaying received identification information and printing received identification information.

36. (Previously Presented) The system as set forth in claim 21, wherein the indication system comprises at least one of a display for displaying received identification information and a printer for printing received identification information.

37. (Previously Presented) The method as set forth in claim 1, wherein the peripheral device is a device selected from a printer, a copy machine, and a facsimile machine.

38. (Previously Presented) The medium as set forth in claim 11, wherein the peripheral device is a device selected from a printer, a copy machine, and a facsimile machine.

39. (Previously Presented) The system as set forth in claim 21, wherein the peripheral device is a device selected from a printer, a copy machine, and a facsimile machine.

REMARKS

This present response replaces the Amendment filed on June 30, 2006, in which the status indicator for claim 21 incorrectly indicated the claim as “Previously Presented.” Because claim 21 was, in fact, amended, the present response corrects the status indicator for this claim.

Claims 1-39 currently are pending. By way of the present response, claims 1, 11, 21 and 25 are amended. Support for the amendments to claims 1, 11 and 25 is found throughout the original disclosure, for example, in Figure 1, and in the specification, at paragraph 0018, and lines 19-22 of paragraph 0022. Claim 25 is amended to correct a minor informality. In view of the above amendments and the remarks advanced below, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims.

In the most recent office action, claims 31- 33 are objected to under 37 CFR § 1.75(c) for allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. The Office asserts that the limitation “receiving a request,” as recited in each of claims 31-33, does not further limit claims 1, 11 and 21 because receiving a request is inherent for information to be received based upon the request. However, the claimed subject matter of “receiving a request” establishes proper antecedent basis for the next recitation “identifying the at least one supplier for the at least one consumable based on the request.” Hence, even if one were to consider that the recitation “receiving the request” is inherent to the processes recited in independent claims 1, 11 and 21, claims 31-33 as a whole do not recite subject matter necessarily inherent to these independent claims. Accordingly, the objection should be withdrawn because claims 31-33 further limit the subject matter of claims 1, 11 and 21, respectively, and thus fully comply with 37 CFR § 1.75(c).

The office action also includes a rejection of claims 1-3, 7-9, 11-13, 17-19, 21-23, 27-29 and 31-39¹ under 35 U.S.C. § 102(e), as being anticipated by Shibata (U.S. Patent Application Publication No. 2002/0008883). In connection with independent claims 1, 11 and 21, the Examiner asserts paragraph 0063 of the Shibata publication discloses a facsimile

¹ It is noted that while the grounds of rejection do not mention claims 31-39, it appears the Examiner intended these claims to be included in the rejection based on sections 7 to 9 of the action.

apparatus that determines if necessary information (shown in Fig. 3) for a sending a toner ordering request is present in the registration unit, Fig. 3 shows service depot (i.e., supplier) information, lines 5-10 of paragraph 0063 discloses a determination of whether the information is in the registration unit 3 (i.e. receiving info identifying the supplier), and paragraph 0064 describes that the generated email 6A indicates the email address of the identified supplier. However, the Shibata publication fails to describe, teach or suggest the features of “requesting, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device … receiving, at the peripheral device via the communications network, information identifying at least one supplier for the at least one consumable based on the request,” as recited in claims 1 an 11, and a system including “a requesting system that requests, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for the at least one consumable for the peripheral device … a receiving system of the peripheral device that receives, via the communications network, information identifying at least one supplier for the at least one consumable based on the request,” as recited in claim 21. Differences between claimed subject matter and the applied Shibata document are now described in detail.

The Shibata publication describes a communications terminal apparatus (e.g., an “Internet facsimile apparatus”) that includes a registration unit (item 3 in Figure 1), which stores pre-registered information about the apparatus, a mail address and a telephone number of a PC used by the manager, and a mail address and a telephone number of the service depot system to which the order for the consumable products such as toner is directed (see, paragraph 47, lines 9-13). According to Shibata, the apparatus automatically sends a maintenance request to a manager supervising the apparatus when a detector detects an event that a consumable product needs replacement/replenishment (see, paragraph 0017). After detecting an event, a main controller of the apparatus (see, item 2 in Figure 1) determines whether information necessary for the transmission of an e-mail is registered in the registration unit (see, paragraph 0063, lines 1-5). If the information needed for sending the e-mail is present, the controller causes an e-mail controller of the apparatus to generate an e-mail and send it to the manager (paragraph 0063, lines 10-18).

The Office asserts that the determination made in Shibata (i.e., whether the necessary information for sending an email is present in the registration unit) is equivalent to claimed features relating to a request made with a peripheral device for an identity of at least one supplier for the at least one consumable for the peripheral device. However, the Shibata facsimile apparatus determines information regarding a supplier only if that information is present in the registration unit in the facsimile apparatus. Moreover, the Shibata apparatus determines e-mail information of the service depot and sends it to the e-mail data generator via a data bus of the apparatus (see paragraph 0034 and item 19 of Figure 1). Hence, Shibata does not describe the processes of “requesting, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device … receiving, at the peripheral device via the communications network, information identifying at least one supplier for the at least one consumable based on the request,” as set forth in amended claims 1 and 11, and similar subject matter recited in amended claim 21 with respect to a system.

In section 10, spanning pages 5 to 6 of the office action, claims 4, 14 and 24 are rejected under 37 U.S.C. § 103 as allegedly being obvious over Shibata.² However, claims 4, 14 and 24 respectively depend from claims 1, 11 and 21, and are allowable at least for the reasons pointed out above. Moreover, claims 4, 14 and 24 recite additional, separately patentable features not taught or suggested in the Shibata publication. For instance, claims 4 and 14 recite “wherein the retrieved information about the peripheral device identifies a location of the peripheral device, and the identifying the at least one supplier is based on the identified location of the peripheral device,” and claim 24 recites subject matter defining similar distinctions not mentioned or suggested in the Shibata publication. In rejecting these claims, the Office asserts the following:

In P[0048] Shibata discloses that there are additional information including the type of toner to be ordered in association with the service depot system 16. The above TTI information identifies the facsimile and that information is associated with the service depot. Shibata does not explicitly disclose that the service depot chosen is based upon the TTI information of the facsimile. However, in P[0048], Shibata discloses that the registration information can contain information about the type of toner, which is based upon the identified facsimile. Thus, it would be obvious to one of ordinary skill in the art at the

² It is noted that claims 4, 14 and 24 depend, respectively, from claims 3, 13 and 23, which in turn depend, respectively, from claims 31, 32 and 33. However, the Office incorrectly asserts that claims 3, 13 and 23 depend from claim 1.

time of invention to know that the service depot chosen is based, at least indirectly, upon the “TTI (i.e. location) of a facsimile device. The motivation would be to allow the correct consumables to be ordered and delivered. (Emphasis added.)

It is respectfully submitted that the Office’s logic in above statements is flawed. First, Shibata does not describe any particulars concerning how a service depot *is chosen*. To the contrary, it would appear that a registered service depot would always respond with its own name, no matter what TTI is received. Second, why would a service depot respond with another service depot’s name? The answer is that it would not, because it doing so would not only change the principle operation of the Shibata apparatus, but would also appear to steer away customers and their business. Furthermore, the motivation provided, “to allow the correct consumables to be ordered and delivered,” is not found in the applied prior art. For at least these reasons, claims 4, 14 and 24 are allowable.

On pages 5 to 6 of the action, claims 5, 15 and 25 are rejected as allegedly being obvious over Shibata in view of Suyehira (U.S. Patent No. 6,947,161). It is respectfully submitted, however, that the Suyehira patent does not remedy the deficiencies pointed out above with respect to Shibata and amended independent claims 1, 11 and 21. The Suyehira patent, like the Shibata publication, is directed an automatic ordering system of a peripheral device. More specifically, Suyehira discloses an automatic ordering system resident in a printer. The automatic ordering system includes an orderer (item 124 in Figure 1) configured to receive notice from a detector (item 120) that toner supply is low, and automatically contact a vendor system (item 104) by way of a browser, a modem, or through a host computer (item 102) (see, column 2, lines 19-22 and column 5, lines 8-17). No process of choosing a vendor is described in the Suyehira patent, and it appears that when an automatic order is placed, a vendor has already been pre-designated like in the Shibata system. Thus, Suyehira does not mention anything whatsoever related to identifying at least one supplier with a peripheral device via a communications network, as presently claimed. Consequently, even if one were to combine the teachings of Suyehira with those of the Shibata publication, any such combination would not have resulted in the combinations of features set forth in amended independent claims 1, 11 and 21, and hence also the features of claims 5, 15 and 25.

In section 12, claims 6, 16, and 26 are rejected under 35 U.S.C. § 103 as allegedly being obvious over Shibata in view of Suyehira, and further in view of the Office Depot Website (previously cited). However, claims 6, 16 and 26 are allowable because respectively depend from amended independent claims 1, 11 and 21, and therefore incorporate all the features of these respective claims. Additionally, the archived website of Office Depot, which is relied upon for teaching a supplier providing information involving available quantity, price, and a way of purchasing at least one consumable, does not remedy the shortcomings of Shibata and Suyehira pointed out above. For instance, the printout of the Office Depot web page provided with the action does not teach or suggest that an identity of at least one supplier of at least one consumable for a peripheral device is requested with a peripheral device via a communications network connected to the peripheral device. Also, the peripheral devices of both Shibata and Suyehira appear to operate to automatically order consumables from only one supplier in a pre-arranged configuration. There is simply no suggestion within these documents that would have motivated one of ordinary skill in the art to provide a web page such as the applied Office Depot Website printout with a peripheral device proposed by the Office.

In addition to the patentable distinctions pointed out above with regard to independent claims 1, 11 and 21, dependent claims 6, 16 and 26 set forth separately patentable subject matter defining further points of distinction. For instance, claims 6 and 16 recite, “wherein the received information further comprises information identifying a price of the at least one consumable at the identified at least one supplier, and the indicating the identified at least one supplier further comprises indicating each identified price of the at least one consumable.” In setting forth the rejection of claims 6, 16 and 26, the Office correctly acknowledges that neither Shibata nor Suyehira discloses the identification of a price of the consumable, but asserts that the printer of Suyehira has a browser stored in the memory capable of accessing the Internet. With reference to Fig. 1, and column 5, lines 12-17 of the Suyehira patent, the Office goes on to assert, “the Suyehira reference discloses a browser capable of accessing the Internet, which means it can access web pages ... The Office Depot website was merely cited to show a price for cartridges that can be ordered. Combining the Shibata and Suyehira inventions, one can obtain a device capable of accessing the internet to obtain such information as the prices of consumables listed in the Office Depot website as cited in the previous Office Action....” However, it is respectfully submitted that there is no

motivation found in any of the Shibata, Suyehira and Office Depot Website documents that would have led one of ordinary skill in the art to make the modifications suggested by the Office. For example, while column 5, lines 12-15 of the Suyehira patent describes using the browser, it is only in the context of automatically contacting a particular vendor system to order a consumable. There is no mention in Suyehira of using the browser to receive and indicate information relating to a price of at least one consumable, as claimed. Also, the Office Depot documents mention nothing with respect to using a browser of a peripheral devices, much less requesting, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for the at least one consumable for the peripheral device, as claimed. Absent any evidence in the prior art for the proposed combination and requisite modifications to meet the claimed subject matter, it is respectfully submitted that Office's reasons for modifying the prior art amount to mere assertions that the applied references can be combined. However, MPEP § 2143.01 instructs that the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness unless the prior art also suggests the desirability of the combination. Accordingly, the features of claims 6, 16 and 26 recite additional distinctions not taught or suggested in the Shibata, Suyehira, and Office Depot Website documents.

Finally, claims 10, 20 and 30 are rejected under 35 U.S.C. § 103 as allegedly being obvious over Shibata in view of Borg et al. (U.S. Patent No. 6,982,801). However, each of claims 10, 20 and 30 ultimately depend from claims 1, 11 and 21, respectively, and the disclosure in the Borg et al. patent of ordering from a manufacturer of a printing device by way of an automatic ordering system or from a menu presented by the automatic ordering system fails to teach or suggest the method and system of the claimed subject matter relating to a request, with a peripheral device via a communications network connected to the peripheral device, of an identity of at least one supplier for at least one consumable for the peripheral device. To the contrary, Borg et al. discloses that a application loaded on the user's computer is supplied by the manufacturer to entice the user to buy consumables from the manufacturer. Indeed, the identity of the supplier (i.e., the manufacturer) is not only known, but appears exclusive of any other suppliers (see, column 1, line 59 to column 2, line 2 and lines 25-28, and column 6, lines 17-19). Hence, there is no need in the Borg et al. system to requesting the identity of a supplier. Accordingly, Borg et al. does not remedy the shortcomings of Shibata with respect to claims 1, 11 and 21, and hence also does not teach or

suggest the combinations including additional features, as recited in dependent claims 10, 20 and 30.

As none the Shibata, Suyehira, the archived Office Depot Website and Borg et al. teach or suggest the presently claimed invention, these documents also fail to provide the advantageous features facilitated by the presently claimed subject matter. For example, when a peripheral device, such as a printer, indicates that a consumable is running low or has run out, a user at the peripheral device can simply press a button (e.g., a physical button on the device or a button displayed on touch screen indicator) *at the peripheral device location* to easily obtain information via an electronic network connection regarding suppliers, availability etc. of the consumable. Additionally, after information is obtained by the peripheral device, the information can be indicated to the user, for example, by displaying it on a display device of the peripheral and/or by printing out the information at the peripheral. These features add ease and flexibility in the process of purchasing consumables for network peripheral devices, stand alone peripheral devices accessible to a communications network, and peripheral devices that allow walk-up use.

In view of all of the foregoing, Applicants submit that the present application is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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/John F. Guay, Reg.# 47248/

John F. Guay

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603-1051
Telephone: (585) 263-1014
Facsimile: (585) 263-1600